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09/964,143	09/25/2001	James Hugh McLaughlin	C&E, JHM-1	1702

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EXAMINER

WANG, SHENGJUN

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/964,143

Applicant(s)

MCLAUGHLIN, JAMES HUGH

Examiner

Shengjun Wang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3, 6, 7, 33, 37 and 39-43 is/are pending in the application.
- 4a) Of the above claim(s) 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3, 6, 7 and 39-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date August 19, 2003.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### DETAILED ACTION

Receipt of applicants' amendments and remarks submitted December 24, 2003 is acknowledged.

#### *Claim Rejections 35 U.S.C. 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3, 6, 33, and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kellner in view of Barker et al. (of record).

3. Kellner teaches water and oil emulsion solid cosmetic compositions. The composition comprising up to 30% of emollient oil, both natural and synthetic oil may be employed (see, particularly, col. 9, line 29 to col. 11, line 62. Kellner further discloses that addition emollient materials, such as fatty alcohol, wax, etc., as oil phase gelling agent may be employed up to 30% (see, particularly, col. 2, lines 66-67; col. 7, line 45 to col. 9, line 26). Kellner further teaches that up to 20 % of primary gelling agent may used, wherein the preferred primary gelling agent are salt of fatty acid, particularly, calcium stearate (see col. 2, lines 24-65). Surfactants up to 20% are desirable in the composition. Surfactants, including cationic, anionic nonionic and zwitterionic surfactants are suitable (see, col. 16, line 9 to col. 19, line 34). The composition may comprising up to 50% of particulate matter, the particulate matter may be organic or inorganic, such as corn starch, mica, etc. (see col. 19, lines 37-61). The water in the composition may range from 5% to 95% (see particularly, the claims).

4. Kellner does not teach expressly the particular percentage of each and every ingredient herein claimed, or the employment of particular ingredients, such as corn starch, calcium stearate, or the employment of sodium chloride as a particulate ingredients.
5. However, Barker teaches sodium chloride particulate are known to be useful in cleansing composition (see claim 5).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a composition with the particular percentages of each and every components herein since the percentage range herein defined are either encompassed by, or overlapped with the range disclosed by Kellner. Note it is well settled that in the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). Also see MPEP 2144.05. The employment of the particular ingredients such as corn starch or calcium stearate is obvious since they are known to be useful in the composition. The employment of such components in the composition is seen to be a selection from amongst equally suitable material and as such obvious. Ex parte Winters 11 USPQ 2<sup>nd</sup> 1387 (at 1388). The employment of sodium chloride is obvious because sodium chloride particulate is known to be useful in cleansing composition.

6. Claims 7, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kellner for reasons discussed above, and in further view of McAtee et al. ((US 6,153,208, ~~claim 7~~) and ~~Touzan et al. (U.S. 6,033,647, claim 38, 39).~~

7. Note Kellner does not teach expressly the employment of the particular oil, or surfactant herein.

However, McAtee disclosed that sodium cocoyl methyl taurate is similarly useful as other anionic surfactant in cleansing composition. (col. 20, lines 1-13).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ sodium cocoyl methyl taurate because sodium cocoyl methyl taurate is known to be useful as anionic surfactant in cosmetic composition.

***Response to the Arguments***

Applicants' amendments and remarks, and the 132 affidavit submitted December 24, 2003 have been fully considered, but are not persuasive for reasons discussed below.

Applicants made three arguments:

(1) Kellner discloses water and oil emulsion cosmetic composition in **solid form** for delivering pigments to the skin that are unlike applicant's claimed exfoliating cosmetic in the form of cream or extrudable paste that cleanse the skin and leave a thin film of emollient thereon.

(2) Kellner teaches that sodium stearate and calcium stearate are equivalent primary gelling agents and that teaching is **false**. (with respect to the equivalents of sodium stearate and calcium stearate).

(3) A principle object of Kellner's invention is cosmetic sticks containing appreciable levels of water" (col. 1, line 35) and appreciable amounts of water" (col. 1, lines 44-45), not applicant's compositions in form of a cream containing 0 - 10% by weight of water.

With respect to point 1, note Question under 35 U.S.C. 103 is not merely what reference expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made; all disclosures of prior art, including unpreferred embodiments, must be considered. In re Lamberti and Konort (CCPA), 192 USPQ 278. Applicants may not ignore the full scope of Kellner's teaching. Kellner et al. provide six objects (see column 1, lines 36-54). First two objects encompass "solid" cosmetic composition which provide cooling feel to the skin, a smooth texture finish when applied to skin, and are capable of moisturizing the skin. Note "solid" therein is defined as solid or semi-solid. See column 2, lines 6-9. Therefore, one of ordinary skill in the art would have understood that Kellner's teaching is not limited to lip stick. Applicant may not take a particular example from Kellner as the full scope of Kellner's teaching.

With respect to applicants' point 2, with the 132 affidavit demonstrating that sodium stearate and calcium stearate are not equally useful as gelling agents in pure water. However, what applicant demonstrated is moot in view of the fact that the cosmetic composition disclosed by Kellner comprises other ingredients, such as oil, surfactant, which may well affect the gelling properties of the composition. Further, one of ordinary skill in the art would not have interpreted Kellner's teaching as sodium stearate and calcium stearate are exactly the same. Selection within the disclosed scope according to a particular composition would have been considered within the skill of the artisan.

8. With respect to applicants' third point, note, as stated above, Applicant may not take a particular example from Kellner as the full scope of Kellner's teaching, and Kellner's teaching would encompass the particular type of cosmetic composition herein claimed.

9. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

10. With respect to the remarks about Barker reference, note Barker teaches the benefit of employ sodium chloride particulate in cosmetic composition. Considering the cited references as a whole, the employment of sodium chloride as particulate ingredient in a cosmetic composition is obvious.

For the reasons discussed above, the examiner believe a prima facie case has been established. Applicant has alleged particular benefit reside on the particular percentages of some ingredients, or specific combination. Regarding the establishment of unexpected results, a few notable principles are well settled. It is applicant's burden to explain any proffered data and establish how any results therein should be taken to be unexpected and significant. See MPEP 716.02 (b). The claims must be commensurate in the scope with any evidence of unexpected results. See MPEP 716.02 (d). Further, A DECLARATION UNDER 37 CFR 1.1323 must compare the claimed subject matter with the closest prior art in order to be effective to rebut a prima facie case if obviousness. Sec, MPEP 716.02 (e). The examiner found no evidence supporting an unexpected benefit.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (571)272-0632. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

SHENGJUN WANG  
PRIMARY EXAMINER

S. Wang  
Shengjun Wang

March 12, 2004